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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,199	11/17/2003	Karissa L. Eckert	86093JLT	3341

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EXAMINER

SCHILLING, RICHARD L

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,199

Applicant(s)

ECKERT ET AL.

Examiner

Richard L Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-17-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-33 are rejected under 35 U.S.C. § 102(a) and (e) as being fully met by Zou et al. (see particularly column 6, lines 9-34; column 8, lines 15-41; column 18, lines 20-36; column 20, lines 24-27; column 22, lines 11-23 and 59-65; column 25, lines 20-41; column 26, lines 7-10; column 27, lines 47-60) discloses photothermographic elements containing silver halide, organic silver salts particularly silver benzotriazole, and reducing agents including ascorbic acid and reductone. The surface pH values of the coatings are reduced to pH values less than 6 by the addition of acid including citric acid. The silver images in Zou et al. may be toned using toning agents including phthalic acid. Phthalic acid and citric acid are within the scope of structural Formula I of instant claim 2.

2. Claims 1-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zou et al. in view of Winslow et al.

'282. Zou et al. discloses photothermographic elements comprising silver halide, organic silver salts, including silver benzotriazole and reducing agents preferably ascorbic acid for use with silver benzotriazole. Zou et al. also discloses using

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toning agents for the silver images including the toning agents of Winslow et al. The toning agents of Winslow et al. include phthalic acid used with photothermographic elements. Therefore, it would be obvious to one skilled in the art to use the toners of Winslow et al. as the called for toners in Zou et al.

3. Claims 1, 2, 4, 6-8, 11-15, 17, 26, 28 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Masukawa et al. in view of Zou et al. Masukawa et al. (see particularly column 5, line 30 - column 6, line 5; column 27, line 65 - column 28, line 68; column 30, lines 16-60; column 2, lines 63-68; Example 1) discloses photothermographic elements comprising silver halide, organic silver salts, reducing agents and toning agents. The preferred organic silver salt is silver benzotriazole and the reducing agents include ascorbic acids. The toning agents include phthalic acid. Example 1 uses silver benzotriazole and phthalic acid. Zou et al. (see particularly column 22, lines 59-65) discloses photothermographic elements with silver halide and organic silver salts and discloses that when silver benzotriazole is used as an organic silver salt, ascorbic acid is the preferred reducing agent. Therefore, it would be obvious to one skilled in the art to use the disclosed ascorbic acids of Masukawa et al. as the called for ascorbic acids in Masukawa et al. particularly in Example 1 which has

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silver benzotriazole and phthalic acid particularly in view of the disclosure in Zou et al. that ascorbic acid is preferably used with silver benzotriazole.

4. Claims 1-4, 6-15, 17, 26, 28 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirai et al. in view of Zou et al. Hirai et al. (see particularly column 1, line 33 - column 2, line 30; column 6, lines 45-60; column 7, lines 51-55; column 12, line 40 - column 13, line 7) discloses photothermographic elements comprising silver halide, organic silver salts including silver benzotriazole wherein acids, including carboxylic acids, are added to the photothermographic layers to lower the pH in order to lower fog and provide high storage stability. Ascorbic acid is not disclosed as a reducing agent. However, since Zou et al. (see particularly column 22, lines 59-65) discloses the use of ascorbic acid as preferred reducing agents in photothermographic elements containing silver benzotriazoles, it would be obvious to one skilled in the art to use ascorbic acid as the called for reducing agent in the photothermographic elements of Hirai et al. containing silver benzotriazole. The acids used in Hirai et al. include those set forth in instant claim 2.

5. The comparisons in applicants' specification are noted but are unconvincing since they fail to show the criticality of

using silver benzotriazole as the organic silver salt and ascorbic acid or reductone as the reducing agents. The comparisons show that acids as set forth in instant claim 2 provide better stability in photothermographic elements but does not show that this better stability is only obtained for photothermographic elements comprising the silver salt of an imino compound with ascorbic acid or reductone reducing agent. Also, the comparisons in the specification are not commensurate in scope with the silver salts of the instant claims since they are limited to using benzotriazole silver salts and not any imino silver salt. Also, it would still be obvious to one skilled in the art to use toning agents including phthalic acid to tone the silver images in the photothermographic elements of the applied prior art even if the phthalic acid has the secondary property of increasing stability.

6. The prior art submitted by applicants has been considered. Lynch et al. is cited of interest in the art as being substantially cumulative to Zou et al. and as being the patent on the cited application Serial No. 193,443. Dooms et al. is cited of interest in the art as disclosing light insensitive thermographic elements comprising organic silver salts and polycarboxylic acids as stabilizers.

7. Any inquiry concerning this communication should be

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directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

February 9, 2005

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 4100 1752

